

1614

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Szelenyi et al. Examiner: Brian Kwon
Serial No.: 10/727,658 Art Unit: 1614
Filed: December 5, 2003 Docket: 6319-1815 (formerly 034082-001)
Title: Combinations of Potassium Channel Openers and Sodium Channel Inhibitors or Sodium Channel -Influencing Active Compounds for Treating Pains

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

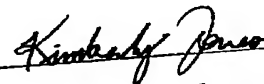
REPLACEMENT TERMINAL DISCLAIMER
TRANSMITTAL

Sir:

As requested by the Examiner in a telephone call to the undersigned on July 24, 2006, enclosed herewith is a terminal disclaimer that replaces the terminal disclaimer which was filed April 3, 2006, in a response to the Office Action dated November 2, 2005. Applicants respectfully request that the enclosed terminal disclaimer be made of record in this application.

If additional fees are due, Applicants authorize the Commissioner to deduct said fees from deposit account number 02-4270.

Certificate of Mailing: I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as First-Class Mail addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on August 4, 2006.



Kimberly Jones
Printed Name

8/4/06
Date

BRMFS1 935512v.1

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Respectfully submitted,

Dated: 4 Aug 2006

Heidi Reese
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Reg. No. 57,841
BROWN RAYSMAN MILLSTEIN FELDER
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U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Docket Number (Optional)
6319-1815

**TERMINAL DISCLAIMER TO OBTAIN A PROVISIONAL DOUBLE PATENTING
REJECTION OVER A PENDING "REFERENCE" APPLICATION**

In re Application of: SZELENYI et al.

Application No.: 10/727,858

Filed: December 5, 2003

For: VALEANT PHARMACEUTICALS INTERNATIONAL

The owner, VALEANT PHARMACEUTICALS INTERNATIONAL, of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of any patent granted on pending reference Application Number 10/727,658 filed on December 5, 2003, as such term is defined in 35 U.S.C. 154 and 173, and as the term of any patent granted on said reference application may be shortened by any terminal disclaimer filed prior to the grant of any patent on the pending reference application. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and any patent granted on the reference application are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 and 173 of any patent granted on said reference application, "as the term of any patent granted on said reference application may be shortened by any terminal disclaimer filed prior to the grant of any patent on the pending reference application." In the event that any such patent granted on the pending reference application expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as shortened by any terminal disclaimer filed prior to its grant.

Check either box 1 or 2 below, if appropriate.

1. ☐ For submissions on behalf of a business/organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the business/organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2. ☒ The undersigned is an attorney or agent of record. Reg. No. 57,841

Heldi Reese
Signature

4 AUGUST 2006
Date

Heldi Reese
Typed or printed name

212-895-2424
Telephone Number

- ☒ Terminal disclaimer fee under 37 CFR 1.20(d) is included.

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

*Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner).
Form PTO/SB/98 may be used for making this statement. See MPEP § 324.

This collection of information is required by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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STATEMENT UNDER 37 CFR 3.73(b)

Applicant/Patent Owner: Valeant Pharmaceuticals North America (formerly known as Xcel Pharmaceuticals, Inc.)
Application No./Patent No.: 10/727,658 Filed/Issue Date: December 5, 2003
Entitled: Combinations of potassium channel openers and sodium channel inhibitors or sodium channel-influencing active compounds for treating pains
Valeant Pharmaceuticals North America a Corporation
(Name of Assignee) (Type of Assignee, e.g., corporation, partnership, university, government agency, etc.)

states that it is:

1. ☒ the assignee of the entire right, title, and interest; or
2. ☐ an assignee of less than the entire right, title and interest.
The extent (by percentage) of its ownership interest is _____ %

In the patent application/patent identified above by virtue of either:

- A ☐ An assignment from the inventor(s) of the patent application/patent identified above. The assignment was recorded in the United States Patent and Trademark Office at Reel _____, Frame _____, or for which a copy thereof is attached.

OR
B ☒ A chain of title from the inventor(s), of the patent application/patent identified above, to the current assignee as shown below:

1. From: Inventors _____ To: VIATRIS GMBH & CO. KG
The document was recorded in the United States Patent and Trademark Office at Reel 015119, Frame 0604, or for which a copy thereof is attached.
2. From: VIATRIS GMBH & CO. KG To: XCEL PHARMACEUTICALS, INC.
The document was recorded in the United States Patent and Trademark Office at Reel _____, Frame _____, or for which a copy thereof is attached.
3. From: XCEL PHARMACEUTICALS, INC. To: VALEANT PHARMACEUTICALS NORTH AMERICA
The document was recorded in the United States Patent and Trademark Office at Reel _____, Frame _____, or for which a copy thereof is attached.

☐ Additional documents in the chain of title are listed on a supplemental sheet.

- ☒ Copies of assignments or other documents in the chain of title are attached.
[NOTE: A separate copy (i.e., a true copy of the original assignment document(s)) must be submitted to Assignment Division in accordance with 37 CFR Part 3, if the assignment is to be recorded in the records of the USPTO. See MPEP 302.08]

The undersigned (whose title is supplied below) is authorized to act on behalf of the assignee.

Robert Chris-Om
Signature
Printed or Typed Name

Feb. 17 2006
Date
714-545-0100
Telephone Number

Vice President, Assistant Secretary
Title
This collection of information is required by 37 CFR 3.73(b). The information is required to obtain or retain a benefit by the public which is so the (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.
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